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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,520	11/21/2005	Herfried Lammer	02418-0913	1370
22852	7590	07/24/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER CHIU, RALEIGH W	
			ART UNIT	PAPER NUMBER
			3711	
			MAIL DATE	DELIVERY MODE
			07/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,520

Applicant(s)

LAMMER ET AL.

Examiner

Raleigh W. Chiu

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11, 13-23 and 25-29 is/are rejected.
- 7) ☒ Claim(s) 10 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “transverse” should be --longitudinal--.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 3-6, 8, 9, 11, 14-23 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,149,090 (Chen et al., hereinafter Chen) in view of U.S. Patent Number 4,732,383 (Ferrari et al., hereinafter Ferrari).

Regarding claims 1, 3-6, 8, 9 and 18-23, Figures 1-3 of Chen show a dampening device fixed to at least two longitudinal strings. Figure 3 best shows the dampening device embracing opposite sides of the strings without enclosing the entire string. Although Chen discloses the dampening device to be made of an elastic device to be made of an elastic flexible material (Chen, column 2, lines 51-59), it would have been obvious to one of ordinary skill in the art to make the Chen dampening device with a foam material in view of Ferrari who teaches that

racquet string dampening devices can also be made from foam. See Ferrari at column 1, lines 54-59.

Regarding claim 11, the hook portions 48 are inherently engageable with each other.

Regarding claims 14-17 and 27, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a foam with the recited physical characteristics, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding new claim 28, because the Chen walls 32 fit tightly against the opposite sides of the strings, a compressive force is produced. Also, see Chen at column 3, lines 10-18.

Regarding new claim 29, the Chen walls 32 correspond to the recited interior surface; sides 26,28 correspond to the recited exterior surface. See Figure 1 of Chen.

5. Claims 7, 12, 13, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen and Ferrari as applied above in view of U.S. Patent Numbers 4,911,445 (Ferrari '445) 5,096,194 (Yong et al., hereinafter Yong) and 5,398,928 (Rudell et al., hereinafter Rudell).

Regarding claims 7, 12, 13, 25 and 26, Ferrari '445 teaches the concept of using hooks to better secure a dampening device to the strings. Further, Yong teaches the concept of using different fasteners such as clips or bolt fasteners to attach a dampening device to a racquet string bed. See Figures 7 and 9. As such, it would have been within the level of ordinary skill in the art to use other types of fasteners as a means of securing a dampening device to racquet strings. Moreover, as Rudell teaches that adhesives, hook-and-loop material and clips were art-recognized equivalents in the gaming art, the selection of any of these known fasteners to attach

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the dampening device to the racquet strings would have within the level of ordinary skill in the art.

Allowable Subject Matter

6. Claims 10 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (571) 272-4408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on (571) 272-4463.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

It is noted that all practice before the Office is in writing (see 37 C.F.R. § 1.2) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations

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(37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority of Petitioner's/Caller action(s).

/Raleigh W. Chiu/

Primary Examiner, A.U. 3711

RWC:dei:feif

17 July 2008